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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,291	03/09/2001	Shimon Shmucli	4989-007	1208
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DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/803,291	Applicant(s) SHMUELI ET AL.	
	Examiner Kieu D. Vu	Art Unit 2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,11-23,25,27-35,37 and 39-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,11-23,25,27-35,37 and 39-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 41 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 41 is rejected as the original disclosure fails to provide support for the subject matter as now claimed.

Specifically, support for the exclusionary statement "without requiring the host computing device to reboot" in claim 41 which was added into the claim by amendment is not found in the original disclosure of the instant application.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. See MPEP 2173.05(i). As such, the limitation(s), *supra*, must be deleted from the claims in response to this action.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5-7, 9, 12-15, 17, 21-23, 25, 28-29, 33-35, 37, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul (USP 5,954,808), Nulu et al ("Nulu", USP 6650347) and Krishan et al (USP 6442529 B1).

Regarding claims 1, 17, and 29, Paul teaches a portable device (configuration card 18) which has a body (see Figure 4B for the body of the configuration card 18), a memory (memory 20) containing software for loading into read/write memory of a host computing device (audiovideo device 10 in Figure 2) and executing on the host computing device (see col. 4, lines 14-40), said software comprising a computer program (computer instruction, col. 4, lines 15-18); an interface to facilitate interaction with the host computing device (communications Interface 22; see col. 3, lines 58-65); and the software adapted to automatically execute on the host computing device in association with a computing session (booting up a processor 24; col. 4, lines 46-50) and provide an interface frame associated with the portable device on a display of the host computing device (col 3, lines 58-65). Paul does not explicitly teach showing an interface frame on the host computing device. However, such feature is known in the art as taught by Nulu. Nulu teaches an apparatus for maintaining networking hardware, Nulu further teaches a GUI having a maintenance menu and a resource tree where the resource tree has an architectural arrangement and a networking resource (col 2, lines 23-27). Nulu further teaches that upon insertion of a card into a hardware box, an interface frame is displayed on the host screen (line 55 of col 13 to line 13 of col 14). Thus, it would have been obvious to one of ordinary skill in the art at the time the

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invention was made to apply Nulu's teaching of displaying an interface frame in Paul's system with the motivation being to enable the user to easily modify the configuration of the system.

Paul differs from the claim in that Paul does not teaches that the software is further adapted to instruct the host computing device to display predefined content wherein the predefined content is associated with a provider of the portable device. However, such feature is known in the art as taught by Krishan. Krishan teaches a method and apparatus for delivering targeted information and advertising over the Internet (col 1, lines 14-20). Krishan further teaches instructing the host computing device to display predefined content wherein the predefined content is associated with a provider of the portable device (Fig. 3, 7-8) (col 4, lines 38-46; col 6, lines 35-48, col 22, lines 8-25). It would have been obvious to one of ordinary skill in the art, having the teaching of Paul and Krishan before him at the time the invention was made, to modify the configuration system card taught by Paul to include displaying predefined content wherein the predefined content is associated with a provider of the portable device taught by Krishan with the motivation being to enable Paul's system to display advertisements on user's screen.

Regarding claims 5-6, 21-22, and 33-34, Paul teaches the providing a link to a web site (user's view to web pages) on the interface frame (col 5, lines 59-63).

Regarding claims 7, 23, and 35, Paul teaches the display the web content in the interface frame (user's view to web pages) (col 5, lines 59-63).

Regarding claims 9, 25, and 37, Krishan teaches message window 64 includes markup language content defined by web content (col 20, lines 8-13).

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Regarding claims 12, 28, and 40, Paul teaches the pushing web content (web pages) (col 5, lines 59-63).

Regarding claims 13-14, Paul teaches the emulating and adapting as a file system (col 3, lines 28-35).

Regarding claim 15, Paul teaches the interfacing a port in the host computing device (col 1, lines 40-45).

5. Claims 11, 27, 39, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul, Nulu, Krishan, and Hendrick (USP 6792464 B2).

Regarding claims 11, 27, and 39, Paul does not teach providing an authentication routine to execute on the host computing device. However, such feature is known in the art as taught by Hendrick. Hendrick's system comprises an authentication routine which verifies user's login identification and password by comparing user's login information with authentication information stored in the memory of the data card (col 4, lines 38-52). It would have been obvious to one of ordinary skill in the art, having the teaching of Paul and Hendrick before him at the time the invention was made, to modify the configuration card taught by Paul to include PIN verification taught by Hendrick with the motivation being to prevent the fraudulent use of the configuration card.

Regarding claim 41, Paul does not teach the software adapted to automatically execute on the host computing device independent of a boot state of the host computing device. However, such feature is known in the art as taught by Hendrick. Hendrick teaches a system for automatic connection to a network, the system enables software contained in a smart card to automatically execute on the system independent

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of a boot state of the host computing device (col 6, lines 18-26) ("upon system", "the system moves to the trigger detection step..." shows that the host computing device is booted). It would have been obvious to one of ordinary skill in the art, having the teaching of Paul and Hendrick before him at the time the invention was made, to modify Paul's system to include the feature that the software can automatically execute on the host computing device independent of a boot state of the host computing device taught by Hendrick with the motivation being to enable the software to execute without having to reboot the computer.

6. Claims 2-4, 18-20, and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul, Nulu, Krishan, and Suga et al ("Suga", USP 5497455).

Regarding claims 2, 18, and 30, Paul does not teach the displaying icon on the interface frame. However, such feature is known in the art as taught by Suga. Suga teaches a portable computer which has a task selection menu which comprises the displaying an icon, which when selected, the software will execute the corresponding function on the host computing device (col 2, lines 26-31). It would have been obvious to one of ordinary skill in the art, having the teaching of Paul and Suga before him at the time the invention was made, to modify the portable device taught by Paul to include the icon display taught by Suga with the motivation being to help user to easily and quickly access functions (Suga, icon screen for task selection, col 2, lines 3-5).

Regarding claims 3-4, 19-20, and 31-32, Suga teaches the display a menu icons corresponding to a menu of function icons (Fig. 4).

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paul, Nulu, Krishan, and Yee et al ("Yee", USP 5781723).

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Regarding claim 16, Paul does not teach a wireless interface. However, such feature is known in the art as taught by Yee. Yee teaches a system for self-identifying a portable information device which comprises the wireless interface (col 4, lines 1-3). It would have been obvious to one of ordinary skill in the art, having the teaching of Paul and Yee before him at the time the invention was made, to modify the portable device taught by Paul to include the wireless interface taught by Yee with the motivation being to enhance the portability of the system by enabling wireless communication between devices (Yee, wireless communication link, col 4, lines 32-37).

8. Response to Applicant's arguments filed 07/05/06.

Applicant's argument "Since booting and rebooting are the exceptions to the norm, the absence of a discussion of the boot requirements in Applicant's specification indicates that Applicant's invention functions normally and does not require a boot or reboot" is not persuasive since negative limitation has to be "positively recited in the specification". "The mere absence of a positive recitation is not basis for an exclusion". (MPEP 2173.05 (i)).

In response to applicant's argument that there is no suggestion to combine Paul and Krishan references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case,

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since both Paul and Krishan teachings are in the same field of executing a software contained in a portable card into a host device, it would have been obvious to one of ordinary skill in the art, having the teaching of Paul and Krishan before him at the time the invention was made, to modify the configuration system card taught by Paul to include displaying predefined content wherein the predefined content is associated with a provider of the portable device taught by Krishan with the motivation being to enable Paul's system to display advertisements on user's screen.

In response to applicant's argument that there is no suggestion to combine Paul, Krishan, and Nulu references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, since Paul, Krishan, and Nulu teachings are in the same field of executing a software contained in a card into a host device, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Nulu's teaching of displaying an interface frame in Paul's system with the motivation being to enable the user to easily modify the configuration of the system.

Applicant argues "the combination does not show an interface frame associated with a portable device". The examiner disagrees. Col 13, lines 55 through col 14, line 13 of Nulu teaches that a maintenance menu will appears as a result of inserting a card

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resource for a line card into the networking hardware box, the maintenance menu has a menu selection option. The maintenance menu can be reasonably interpreted as "interface frame" since it is a bordered space that contains information and that enables user interaction with the system.

Applicant argues "the interface frame of the present invention frame has a spot in which the content can be displayed; it is similar to a "window" that is distinct from the browser, rides on top of the browser, and may lie on top of the normal task bar that is present at the top of a browser window (see Figs. 5 and 6), it is noted that these limitation is not recited in the claims. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., similar to a "window" that is distinct from the browser, rides on top of the browser, and may lie on top of the normal task bar that is present at the top of a browser window) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's argument "The card of Nulu is not a portable device. Since there is no portable device, there can be no interface frame associated with a portable device" attacks the reference individually since the main reference Paul teaches a portable device as seen in the rejection of claim 1 above. Paul does not explicitly teach showing an interface frame on the host computing device. Nulu is cited for showing an interface frame on the host computing device. In response to applicant's arguments against the

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references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant's argument regarding the motivation to combine Hendrick with references is not persuasive. Since Paul desires to have "an apparatus that prevents" "unauthorized access" (Paul, col 2, lines 10-12), it would have been obvious to one of ordinary skill in the art, having the teaching of Paul and Hendrick before him at the time the invention was made, to modify the configuration card taught by Paul to include PIN verification taught by Hendrick with the motivation being to prevent the fraudulent use of the configuration card.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kieu D. Vu. The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM at 571-272-4057.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached at 571-272-4048.

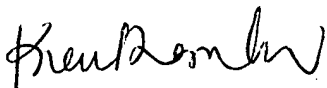
The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

571-273-8300

and / or:

571-273-4057 (use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper / amendment be faxed directly to them on occasions).

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Kieu D. Vu
Primary Examiner